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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,149	12/02/2003	David K. Swanson	015916-302	5299

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EXAMINER

VRETTAKOS, PETER J

ART UNIT	PAPER NUMBER
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3739

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/727,149		SWANSON, DAVID K.	
	Examiner		Art Unit	
	Peter J. Vrettakos		3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-15, 18-28, 30, 31, 34-37 and 47-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-15, 18-28, 30, 31, 34-37 and 47-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11-13-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Applicant has elected without traverse, claims 1-4, 7-15, 18-28, 30-31, 34-37 and 47-50. Of elected claims, 1, 12, 23 and 50 are independent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-15, 18-28, 30-31, 34-37 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erb et al. (6,364,876) in view of Jahns et al. (6,558,382).

Erb discloses an apparatus (25) for use with an EP device (20) with a coagulation element (23), the apparatus comprising a main body (52) with suction regions with suction ports (76, see figure 13), vacuum source (75) and a connector (slot 36, figure 5, col. 7:48-51).

Jahns discloses an EP device and apparatus analogous to Erb's EP device and apparatus. See figures 4, 5 and 7 in Jahns. Each figure depicts a different embodiment in which the placement of suction ports and electrodes are varied. Electrodes (422, 522, 90 can be sensing as in figure 7 or stimulating) and suction ports (444, 544, 786) are disclosed. To this end, it would have been obvious to include the Jahns electrodes (522) adjacent to the Erb suction ports (76) in figure 13 as yet another design variation in the

spirit seen in Jahns. The motivation would be to provide an additional embodiment as implied as beneficial through Jahns' disclosure of numerous embodiments.

Response to Arguments

Applicant's arguments filed 12-7-06 have been fully considered but they are not persuasive.

Applicant argues the Erb lacks a stimulation element, a stimulation-sensing element, a connector located between the stimulation element and the stimulation energy sensing element. The following explanation will clarify just how these arguments are not relevant/correct. The rejection above starts with the Erb embodiment in figure 13, which depicts suction regions (76) and a connector (recess 43 in figure 13 – represents closest enumerated element to 36 in figure 5). Jahns discloses in figure 5, element 522 (which is adjacent to suction regions 544). Element 522 is analogous to Jahns element 90, which is an electrode therefore qualifying 90 and 522 as either a stimulation element (an emitter of energy – ex. ablation electrode) and/or a stimulation energy sensing element (a sensor – ex. mapping electrode). The Office is arguing that would have been obvious to place Jahns element 522 in figure 5 adjacent to Erb element 76 in figure 13. (Remember that Jahns figure 5 shows an analogous structure with suction regions 544 adjacent to stimulation/stimulation energy sensing element 522.) This speculated hybrid would make also obvious a connector (43 in figure 13) that is in between (longitudinally) Erb element 76 and Jahns element 522. Being that each

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Jahns element 522, of which there are a plurality, can be either a stimulation element or a stimulation energy sensing element, that would mean that 522 located on each side of connector 43 would result in the connector in between a stimulation element and a stimulation energy sensing element were an engineer to chose placement of a stimulation element on one side of element 43 and a stimulation energy sensing element on the other side of element 43. To this end, Erb's lack of stimulation element and stimulation sensing elements is not relevant. The elements are made obvious by Jahns element 522. Further, Erb makes obvious a connector 43 in between stimulation elements (Jahns 522) and stimulation sensing elements (Jahns 522) for the reason elaborated just above.

The Examiner's "novel" position to combine Erb and Jahns in manner making obvious the Applicant's claims are rooted in common sense. In a patent with numerous embodiments in which numerous configurations of elements are shown, such as Jahns, the commonsensical implication is that mixing and matching of elements is encouraged and at least permitted. The merit of mixing and matching is to optimize a device's known design. Optimization includes an inherent motivation as seen in MPEP § 2144.5

II. OPTIMIZATION OF RANGES

A. Optimization Within Prior Art Conditions or Through Routine Experimentation

Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.); see also *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969) (Claimed elastomeric polyurethanes which fell within the broad scope of the references were held to be unpatentable thereover because, among other reasons, there was no evidence of the criticality of the claimed ranges of molecular weight or molar proportions.). For more recent cases applying this principle, see *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10

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USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

The Office's position is that mixing and matching elements in light of Erb and Jahns and eventually arriving at the Applicant's invention would have occurred through routine experimentation as motivated by the normal desire to improve upon what is already in the two patents (the numerous embodiments in patents).

Furthermore, with regards to the commonsensical implication above, the Federal Circuit recently in *Dystar Textilfarben v. C.H. Patrick*, 464 F.3d 1356 supported this commonsensical proposition by writing that the motivation/suggestion test is "quite flexible" and requiring "consideration of common knowledge and common sense". Further, the court indicated that the motivation to combine need not to be in the references that are being combined and instead can come from common knowledge. The Office contends that numerous embodiments invites routine experimentation and optimization to determine better combinations, and that this proposition is commonsensical, provides a rational underpinning (optimize) and is not merely conclusory and subjective. To these ends, the rejections are maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

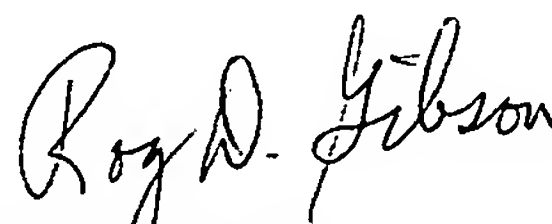
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pete Vrettakos
January 3, 2007




ROY D. GIBSON
PRIMARY EXAMINER